



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,783	11/30/2000	Jurgen Pingel	P-4582	2695

7590 03/22/2004  
Forrest Gunnison  
Gunnison, McKay & Hodgson, L.L.P.  
1900 Garden Road, Suite 220  
Monterey, CA 93940

EXAMINER

WONG, LESLIE

ART UNIT	PAPER NUMBER
----------	--------------

2177

10

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/728,783

Applicant(s)

PINGEL ET AL.

Examiner

Leslie Wong

Art Unit

2177

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 1-24.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's amendment necessitated the new ground of rejection. Applicant's Amendment A, submitted on 26 June 2003, has changed the scope of the claim from "entering inputted reference..." to "entering user inputted reference... citation to said user inputted reference data". The Examiner presented new ground of rejection in Final Office Action, dated 06 December 2003, to address Applicant's newly added limitation. Therefore, mentioned Final Office Action with new prior art is proper. See MPEP 706.07(a).

In Applicant's Response After Final, Applicant states that Examiner gave no rational as to why it was necessary to treat claims 7 and 24 differently in the Final Office Action. Examiner submits that claims 7 and 24 depend on claims 1 and 22, respectively. The scope of claims 1 and 22 have changed; Therefore, the grouping for claims 7 and 24 also change according to its independent claims.

Further, Applicant argues that Examiner has cited no reference for the conclusion that follows the description of an assistant agent. Examiner submits it should be understood by one of the ordinary skilled in the art that an assistant agent's function is to perform tasks based on user's instructions; therefore, it is similar to that of the user performing the tasks on his own. Hence, Lawrence implicitly teaches the limitation as claimed.

Last, Applicant's arguments, on page 6 of the Response After Final submitted on 10 March 2004, seem to be suggesting that there is no suggestion to combine the references. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lawrence et al. does not explicitly teach a step of storing the reference database and other data of the computer-readable document in a single data file. Amro et al., however, teaches a compound document contains multiple objects capable of running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc... (col. 4, lines 4-7). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to store document related data in the same file because doing so would ensure that reference data is always available for access.



Leslie Wong  
Patent Examiner  
Art Unit 2177

JEAN R. HOMERE  
PRIMARY EXAMINER

